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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,692	11/26/2003	James B. McCormick	46521-56177	8923
21888	7590	11/30/2007		
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500. ST LOUIS, MO 63101				
			EXAMINER RAMILLANO, LORE JANET	
			ART UNIT 1797	PAPER NUMBER
			NOTIFICATION DATE 11/30/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary	Application No. 10/723,692	Applicant(s) MCCORMICK, JAMES B.	
	Examiner Lore Ramillano	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant's reply filed on 8/30/07 is acknowledged. Claims 1-10 are pending. Claims 1-7 are under examination.
2. This application contains claims 8-10 drawn to an invention nonelected without traverse in the reply filed on 4/6/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendment

Prior art rejections

3. The rejections by Dyke and Dyke in view of Rochette are maintained. The rejection by Tanaka is withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2, and 5-7** are rejected under 35 U.S.C. 102(b) as being anticipated by Dyke (US 4874090).

In figures 1 and 2, Dyke discloses a foldable permeable sheet having edges; a permeable target disposed on the foldable permeable sheet within the edges of the sheet; and a malleable securing strip attached to the foldable permeable sheet of a length sufficient to secure the folded flap portions overlapping the target (i.e. column 2, line 35 to column 3, line 49).

Dyke further discloses, in figures 1 and 2, the following: that the malleable securing strip is attached at an edge of the permeable sheet; the target is coated with a release agent; the permeable target is a permeable paper sheet; and an X and Y coordinate marking lines on the permeable target (i.e. column 2, line 35 to column 3, line 49).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyke in view of Rochette (US 3537636).

The disclosure of Dyke is stated above. Dyke does not specifically disclose having a malleable securing strip comprising a metal wire or a metal foil.

In figures 1-4, Rochette discloses an invention consisting of a reclosable bag formed from a sheet of flexible material. The bag further comprises a bendable metal wire and a pair of flexible coverings strips (i.e. metal foil), which are sealed together and the wire is sandwiched between so that the wire is embedded between the strips (i.e. column 2, line 70 to column 3, line 8). It would have been obvious to a person of ordinary skill in the art to modify Dyke's malleable securing strip with a metal wire and/or with a metal foil because it would be beneficial to have a sealing means that provides reinforcement.

Response to Arguments

8. Applicant's arguments, see p. 4-5, filed 8/30/07, with respect to the rejection by Tanaka have been fully considered and are persuasive. This rejection has been withdrawn.

9. Applicant's arguments filed on 8/30/07, with respect to the rejection by Dyke and Dyke in view of Rochette, have been fully considered but they are not persuasive.

102 Rejection by Dyke

In response to applicant's argument that the materials forming the sheets of the pouch in the Dyke reference are not permeable as set forth in the claims and therefore would not enable the pouch in the Dyke reference to perform as a histological specimen retaining device, examiner disagrees. Dyke reads on applicant's permeable sheets because Dyke discloses in column 2, lines 1-9, for example, that his sheets are permeable to gases. With regard to applicant's latter argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, because Dyke reads on the structural limitations recited in applicant's claims, Dyke properly reads on the intended use language recited in applicant's claims.

In response to applicant's argument that Dyke fails to disclose providing a target with a permeable material, examiner disagrees. Dyke reads on applicant's permeable target because Dyke discloses in fig. 1, reference numeral 14, the recited permeable target. Applicant should note that pending claims are given their broadest reasonable interpretation consistent with the specification. It is improper for the examiner to import into a claim limitations from the specification. Here, it appears that Dyke's permeable target (14) properly reads on applicant's permeable target.

In response to applicant's argument that Dyke fails to show a flap, much less one which overlaps the target, examiner disagrees. Dyke reads on applicant's extended flap portions because the portions of reference numeral 12, which are not covered by reference numeral 14, are capable of folding over and overlapping the target (14). Furthermore, because the claim language, "foldable," is functional language, Dyke properly reads on such language since Dyke reads on the structural features of applicant's invention.

In response to applicant's argument that Dyke teaches away from folding over a flap to form an overlapping structure, examiner does not find this argument convincing. Arguments that the alleged anticipatory prior art "teaches away" from the invention are not germane to a rejection under section 102.

103 Rejection

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Dyke and Rochette read on applicant's invention because there is some motivation to combine the references. As stated above, it would be beneficial to have a sealing means that provides reinforcement.

In response to applicant's arguments that there is no reason to provide a reusable and reclosable sealing device as set forth in the Rochette reference on a sterilization pouch as set

forth in the Dyke reference that is intended to be used one time. Examiner does not find this argument convincing because examiner has pointed out in paragraph 7 above, that the motivation to include a metal wire and/or metal foil to Dyke's malleable securing strip is to provide reinforcement and not to reuse Dyke's device. Thus, the proposed modification to Dyke does not render Dyke unsatisfactory for its intended purpose.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lore Ramillano
Examiner
Art Unit 1743


Jill Warden
Supervisory Patent Examiner
Technology Center 1700